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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,485	03/13/2001	James B. Pugh	P/52-3	3758
7590 Philip M. Weiss, Esq. Weiss & Weiss Suite 251 300 Old Contry Road Mineola, NY 11501				
			EXAMINER	
			CHANDLER, SARA M	
			ART UNIT	PAPER NUMBER
			3693	
			MAIL DATE	DELIVERY MODE
			02/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/805,485

Applicant(s)

PUGH, JAMES B.

Examiner

SARA CHANDLER

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for continued examination of application 09/805,485 (03/13/01) filed on 09/22/08.

Applicant's election of Group II (Claims 15-17 and 19) in the reply filed on 12/15/08 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result, but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result, but does not result in a structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as “*if, may, might, can could*”, as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as “*wherein, whereby*”, that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-17 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

In order for a method to be considered a "process" under 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *In re Bilski*, 88 USPQ2d 1385, 1391 and 1396 (2008).

Re Claim 15: Although the claimed method makes reference to a "shopping cart" or "the internet", this is considered a nominal recitation of another statutory class because an underlying system itself is not performing the actively recited steps or acts of the claimed method/process but, rather these steps are performed by a human operator alone. For example, steps or acts such as logging on to the internet, choosing

a shopping cart, creating a merchant account and submitting corresponding information to entities such as a bank or processing center may all be performed by a human operator alone.

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is rejected for the following:

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, essential steps and/or essential structural cooperative relationships of elements such omission amounting to a gap between the elements, the steps and/or the necessary structural connections . See MPEP § 2172.01. The omitted elements, steps and/or structural cooperative relationships are:

It is unclear a) what steps or acts are performed by human operators in conjunction with the underlying system and what steps are performed by the underlying system; and b) how the particular steps performed relate to the other steps recited in the invention as claimed.

The claim recites the limitation, "logging onto the Internet." The step is unrelated to the other steps performed. Is this step done by a customer/user?

The claim recites the limitation, "providing a shopping cart selection and merchant account application;" Is the merchant account application, merchant account and merchant account information related. If so, their relationship should be clarified in the claimed invention.

The claim recites the limitation, "linking an e-commerce shopping cart to a processing center;" Does this occur as a result of providing the shopping cart selection. If so, that should be clarified in the claim. The claimed invention refers to a "bank", "processing center" (i.e., in singular form) and other times "banks", "processing centers" (i.e., in plural form). It is unclear what is intended. Consistent form and terminology should be used.

The claim recites the limitation, "choosing a shopping cart;" Is this "shopping cart" the same as the "e-commerce shopping cart." If so, consistent terminology should be used. Also, subsequent references to terms should be preceded with "said" or "the". Is this step done by a customer/user?

The claim recites the limitation, "creating a merchant account;" Is the merchant account application, merchant account and merchant account information related. If so, their relationship should be clarified in the claimed invention. Is this step done by a customer/user?

The claim recites the limitation, "providing merchant account information;" Is the merchant account application, merchant account and merchant account information related. If so, their relationship should be clarified in the claimed invention. Is this step done by a customer/user?

The claim recites the limitation, "submitting said merchant account information to a bank;" The claimed invention refers to a "bank", "processing center" (i.e., in singular form) and other times "banks", "processing centers" (i.e., in plural form). It is unclear what is intended. Consistent form and terminology should be used.

The claim recites the limitation, "notifying said merchant of banks who approved said merchant processing request and processing center and interest rates of said banks;" The limitation "said merchant". There is insufficient antecedent basis for this limitation in the claim. The claimed invention refers to a "bank", "processing center" (i.e., in singular form) and other times "banks", "processing centers" (i.e., in plural form). It is unclear what is intended. Consistent form and terminology should be used. The meaning of the claim limitation is unclear because the merchant processing request was only sent to processing centers and not any banks, only one bank was previously mentioned not a plurality; and no banks have approved anything in the claimed invention.

The claim recites the limitation, "wherein said interest rates correspond to said request for quotes;" What is "said request for quotes"? Is it the "merchant processing request" for "transaction processing quotes"? If so, consistent terminology should be

used. Furthermore, the meaning of the claim limitation is unclear because the merchant processing request was only sent to processing centers and not any banks, only one bank was previously mentioned not a plurality; and no banks have approved anything in the claimed invention. Also, subsequent references to terms should be preceded with "said" or "the".

The claim recites the limitation, "selecting said bank and processing center;" The claimed invention refers to a "bank", "processing center" (i.e., in singular form) and other times "banks", "processing center" (i.e., in plural form). It is unclear what is intended. Consistent form and terminology should be used. It is unclear how the selection of which bank and processing center is made and if it is made by a specific user or the underlying system.

The claim recites the limitation, "providing a quote to said user from said processing center;" There is insufficient antecedent basis for "said user" in the claim. Is the user a customer/merchant? The claimed invention refers to a "bank", "processing center" (i.e., in singular form) and other times "banks", "processing center" (i.e., in plural form). It is unclear what is intended. Consistent form and terminology should be used. What is "a quote"? Is it one of the "transaction processing quotes" requested? If so, consistent terminology should be used. Also, subsequent references to terms should be preceded with "said" or "the".

The claim recites the limitation, "wherein if said user does not get a processing center quote, an ASP/e-commerce site programming organization downloads Internet

service access processing engine and links said user to an e-commerce site. " As noted supra, there is an issue regarding who " the user" is (e.g., customer/merchant). What is "a processing center quote"? Is it a "a transaction processing quote"? If so, consistent terminology should be used. . Also, subsequent references to terms should be preceded with "said" or "the". The "if" recited in "wherein if said user does not get a processing center quote" is optional or conditional language. There is no requirement if the user does get a processing center quote. See MPEP § 2106 II.(C).

Claim 16 recites, "wherein said shopping cart is selected from the group consisting of an Internet service access processor combined shopping cart, or another shopping cart or e-commerce existing platform." Is this really a closed groups? In other words, the language "another shopping cart" allows the limitation to read on any shopping cart. Furthermore, it is unclear what is "said shopping cart. The claim depends from claim 15 which has two different shopping carts (i.e., an e-commerce shopping cart" and "a shopping cart"). It is unclear whether these are intended to be the same shopping cart or different shopping carts.

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colvin, Sr., US Pat. No. 5,825,881 in view of Moyer, US Pub. No. 2003/0088483.

Re Claim 1: Colvin, Sr. discloses a method for providing financial transactions on the Internet comprising:

logging onto the Internet (Colvin, Sr., abstract, col. 1, lines 48-52; col. 2, lines 51-56; col. 9, lines 17-27);

providing a shopping cart selection and merchant account application (Colvin, Sr. abstract, col. 1, line 48+ - col. 2, line 15; col. 3, lines 10-33; col. 5, lines 14 - 45);

linking an e-commerce shopping cart to a processing center (Colvin, Sr. abstract, col. 1, lines 48+ - col. 2, line 15; col. 2, lines 50+ - col. 3, line 33; col. 4, lines 18 - 53; col. 5, lines 14 - 45; col. 6, lines 25 - 28; col. 7, lines 4-6);

choosing a shopping cart (Colvin, Sr. abstract, col. 1, line 48+ - col. 2, line 15; col. 3, lines 10-33; col. 5, lines 14 - 45);

creating a merchant account (Colvin, Sr. abstract, col. 1, lines 48+ - col. 2, line 15; col.

2, lines 50+ - col. 3, line 33; col. 4, lines 18 - 53; col. 5, lines 14 - 45; col. 6, lines 25 - 28; col. 7, lines 4-6);

providing merchant account information (Colvin, Sr. abstract, col. 1, lines 48+ - col. 2, line 15; col. 2, lines 50+ - col. 3, line 33; col. 4, lines 18 - 53; col. 5, lines 14 - 45; col. 6, lines 25 - 28; col. 7, lines 4-6);

submitting said merchant account information to a bank (Colvin, Sr. abstract, col. 1, lines 48+ - col. 2, line 15; col. 2, lines 50+ - col. 3, line 33; col. 4, lines 18 - 53; col. 5, lines 14 - 45; col. 6, lines 25 - 28; col. 7, lines 4-6);

submitting a merchant processing request to processing centers for transaction processing quotes (Colvin, Sr. abstract, col. 1, lines 48+ - col. 2, line 15; col. 2, lines 50+ - col. 3, line 33; col. 4, lines 18 - 53; col. 5, lines 14 - 45; col. 6, lines 25 - 28; col. 7, lines 4-6);

notifying said merchant of banks who approved said merchant processing request and processing center (Colvin, Sr. abstract, col. 1, lines 48+ - col. 2, line 15; col. 2, lines 50+ - col. 3, line 33; col. 4, lines 18 - 53; col. 5, lines 14 - 45; col. 6, lines 25 - 28; col. 7, lines 4-6);

selecting said bank and processing center (Colvin, Sr. abstract, col. 1, lines 48+ - col. 2, line 15; col. 2, lines 50+ - col. 3, line 33; col. 4, lines 18 - 53; col. 5, lines 14 - 45; col. 6, lines 25 - 28; col. 7, lines 4-6);

providing a quote to said user from said processing center (Colvin, Sr. abstract, col. 1, lines 48+ - col. 2, line 15; col. 2, lines 50+ - col. 3, line 33; col. 4, lines 18 - 53; col. 5,

lines 14 - 45; col. 6, lines 25 - 28; col. 7, lines 4-6);

wherein if said user does not get a processing center quote, an ASP/e-commerce site programming organization downloads Internet service access processing engine and links said user to an e-commerce site (Colvin, Sr., abstract, col. 1, lines 48-52; col. 2, lines 51-56; col. 9, lines 17-27).

Colvin, Sr. fails to explicitly disclose:

wherein notifying said merchant of banks who approved said merchant processing request and processing center further includes interest rates of said banks; and wherein said interest rates correspond to said request for quotes.

Moyer discloses:

wherein notifying said merchant of banks who approved said merchant processing request and processing center further includes interest rates of said banks (Moyer, Fig. 10, [0146]); and

wherein said interest rates correspond to said request for quotes (Moyer, Fig. 10, [0146]);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Colvin, Sr. by adopting the teachings of Moyer to provide wherein notifying said merchant of banks who approved said merchant processing request and processing center further includes interest rates of said banks; and wherein said interest rates correspond to said request for quotes.

The claimed invention applies a known technique to a known device (method,

computer program product) ready for improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claim 16: Colvin, Sr. in view of Moyer discloses the claimed invention supra and Colvin Sr. further discloses wherein said shopping cart is selected from the group consisting of an Internet service access processor combined shopping cart, or another shopping cart or e-commerce existing platform (Colvin, Sr. abstract, col. 1, line 48+ - col. 2, line 15; col. 3, lines 10-33; col. 5, lines 14 - 45).

Re Claim 17: Colvin, Sr. in view of Moyer discloses the claimed invention supra and Colvin, Sr. further discloses wherein said another shopping cart has a payment processing platform (Colvin, Sr. abstract, col. 1, lines 48+ - col. 2, line 15; col. 2, lines 50+ - col. 3, line 33; col. 4, lines 18 - 53; col. 5, lines 14 - 45; col. 6, lines 25 - 28; col. 7, lines 4-6).

Re Claim 19: Colvin, Sr. in view of Moyer discloses the claimed invention supra and Colvin, Sr. further discloses wherein said ASP/e- commerce site programming organization performs a transaction test (Colvin, Sr., abstract, col. 1, lines 48-52; col. 2, lines 51-56; col. 9, lines 17-27).

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC
/JAGDISH N PATEL/
Primary Examiner, Art Unit 3693